

## **REMARKS**

Claims 1, 3-7 and 9-23 remain pending in the present application. The claims have not been amended in response to this Office Action.

### **REJECTION UNDER 35 U.S.C. § 103**

Claims 1, 3-7, 10, 11 and 13-19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ergun (U.S. Pat. No. 4,823,922) in view of Henry-Biabaud (U.S. Pat. No. 3,432,008). Applicants respectfully traverse this rejection. The Examiner's position is that Ergun teaches a shock absorber disclosing the elements of the present invention except that Ergun fails to teach adjustable valve. The Examiner then goes to Henry-Biabaud to find adjustable valves. The Examiner states that Ergun teaches that the valves can be designed to actuate at different opening pressures to achieve a desired damping characteristic, see column 5, lines 46-47. The Examiner interprets this as being capable of actuating at a different individually adjustable valve opening pressure in rebound and compression.

Applicants respectfully traverse this interpretation by the Examiner. It is Applicants' position that the Examiner has clearly used non-permissible hindsight gleaned from Applicants' disclosure to arrive at this interpretation. Ergun teaches away from having the individual valves open at different pressures.

First, the abstract describes that identical valve assemblies are positioned in the passages. Certainly, valves opening at different pressure would not be termed identical.

Further, column 1, lines 35-37 states that the rebound and compression valve assemblies are geometrically identical. Only their directions are reversed. Again, valves opening at different pressures would not be termed geometrically identical.

While column 5, lines 46 and 47 state that valve springs and pins can be modified to effect the desired damping characteristics, there is nothing in this statement which would provide support for the Examiner's position of individually adjustable valves. The only support for this interpretation by the Examiner is Applicants' disclosure.

Column 6, lines 58-60 of Ergun also teaches against individually adjustable valves. Lines 58-60 state that if low damping is of concern, a low speed damping passage 156 is defined to circumvent valve head 22 as shown in Figure 14. The present invention incorporates individual adjusted valves to define the damping characteristics.

Finally, Claim 1 in lines 51-53 of column 8 defines "a series of identically dimensionally configured valve assemblies positioned within said valve openings" (emphasis added). Identically dimensionally configured valve assemblies cannot have different valve opening pressures as is defined in the present invention. Henry-Biabaud illustrates valve assemblies having threaded connections for biasing a spring, but Henry-Biabaud does not disclose, teach or suggest a different opening pressure for the compression and rebound valve assemblies.

Ergun taken alone or in combination with Henry-Biabaud does not disclose, teach or suggest Applicants' claimed invention. The Examiner has based his interpretation of Ergun and/or Henry-Biabaud that the individual valve assemblies can

have different opening pressures on Applicants' disclosure which is impermissible use of hindsight.

Thus, Applicants believe Claims 1, 3-7, 10, 11 and 13-19 patentably distinguish over the art of record. Reconsideration of the rejection is respectfully requested.

Claim 9 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Ergun in view of Henry-Biabaud as applied to claim 1 above, and further in view of Harper, et al. (U.S. Pat. No. 4,596,321). Applicants respectfully traverse this rejection. Claim 9 ultimately depends from Claim 1. As detailed above, Claim 1 is believed to patentably distinguish over the art of record. Thus, Claim 9 is also believed to patentably distinguish over the art of record. Reconsideration of the rejection is respectfully requested.

Claims 20, 21 and 23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ergun in view of Henry-Biabaud and in view of Katz (U.S. Pat. No. 4,624,346). Applicants respectfully traverse this rejection. Claim 20 is a method claim which defines the rebound and the compression valves as opening sequentially upon exposure to a predetermined set of increasing fluid pressures. The above discussion of Ergun and Henry-Biabaud applies here also. Katz does not provide support for the Examiner's interpretation either. Thus, Applicants believe Claims 20, 21 and 23 patentably distinguish over the art of record. Reconsideration of the rejection is respectfully requested.

Claim 22 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Ergun in view of Henry-Biabaud and Katz as applied to claim 20 above, and further in view of Harper, et al. (U.S. Pat. No. 4,596,321). Claim 22 ultimately depends from Claim 20.

As stated above, Claim 20 is believed to patentably distinguish over the art of record. Thus, Claim 22 is also believed to patentably distinguish over the art of record. Reconsideration of the rejection is respectfully requested.

#### **CONCLUSION**

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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